



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,833	02/22/2002	Jacques Alain Deverin	H 5369 US	3113

7590

09/17/2003

George L. Snyder, Jr.  
Hodgson Russ LLP  
Suite 2000  
One M&T Plaza  
Buffalo, NY 14203-2391

EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/081,833	DEVERIN, JACQUES ALAIN	
	Examiner	Art Unit	
	Thong Q. Nguyen	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

In the Oath/Declaration filed on 2/22/2002, applicant has stated that there is not any certified copy of the foreign application is attached. However, a copy of the foreign application is later filed and received by the Office on 5/6/2002. For the purpose of making the Oath/Declaration clear about the filing of the foreign application under rule 35 USC 119, applicant is advised to file a new Oath/Declaration to confirm the filing of the foreign application under rule 35 USC 119.

### ***Drawings***

3. The drawings were received on 2/22/2002. These drawings are objected by the Examiner for the following reasons.
4. The structure of the system as shown in figure 1 is readable from the prior art as described in pages 1-2. Thus, Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office

Art Unit: 2872

action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature relating to the slidable prisms as recited in claim 3 and the use of at least two optical switchers which have different functions as recited in claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The disclosure is objected to because of the following informalities: 1) the Summary of the invention is too long and contains details/information of the conventional art. Applicant is respectfully invited to review rule 37 CFR 1.73 and MPEP 601 which requires a brief summary of the invention; 2) Page 8: lines 14-15, "left beam path 1 and right beam path r" should be changed to – left beam path L and right beam path R –. The reason of this suggestion is found in the figure 1 in which the terms "L" and "R" are used; 3) Page 9: lines 20-21, "(1) or right (R)" should be changed to – (L) or

Art Unit: 2872

right (R) – (see the same suggestion as listed above; 4) Page 9: line 26, -- 2—should be added after “module”. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 3 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Claim 3 is rejected under 35 USC 112, first paragraph because it is unclear about the use of slidable prisms as optical switchers. It is noted that the specification refers to the use of Rhomboid prisms as optical switchers. The connection of the Rhomboid prisms with their correspondent imaging module/display module is changeable by rotation or slide. While the changeability of the connection among the Rhomboid prisms with their correspondent imaging module/display module is readable from the figure 2; however, the changeability of the connection among the Rhomboid prisms with their correspondent imaging module/display module by a slide is unclear based on the absence of

Art Unit: 2872

teaching/information relating to the so-called "slidable prisms". Applicant should note that since the surface appeared on the right side of each prism, for example, prism 5, appeared as a total reflecting surface; therefore, when a slide to the left direction of the prism (5) will not allow the transmission of light from the display to the splitter ( $\propto$ ).

b) The remaining claim is dependent upon the rejected base claim and thus inherits the deficiency thereof.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 is rejected under 35 USC 112, second paragraph because it is unclear about the beam splitter recited on last two lines of the claim. It is noted that the claim recites a plurality of beam splitters as can be seen on line 7 of the claim; however, it is unclear which beam splitter is referred to by the feature thereof "the beam splitter" (last two lines of the claim).

b) Claim 7 is rejected under 35 USC 112, second paragraph because it is unclear about the structural relationship among the switchers, the imaging module and the display module as recited in the claim so that the imaging module and the display module cannot be connected simultaneously to the same channel. In

Art Unit: 2872

other words, the connection/couple defined by "in such a way" (lines 3-4) is unclear.

c) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiency thereof.

***Objection***

12. Claim 12 is objected to because of the following informalities: The feature relating to "device" recited on line 1 lacks a proper antecedent basis. In claim 12: on line 1, "or device" should be deleted. Applicant should note that the base claim 1 does not provide antecedent basis for the term "device". Appropriate correction is required.

***Allowable Subject Matter***

13. Claims 1-2, 4, and 6-11 would be allowable if each of claims 1 and 7 is rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

14. Claim 12 would be allowable if rewritten to overcome the objection set forth in this Office action.

15. The following is an examiner's statement of reasons for allowance:

The instrument as recited in present claim 1 is patentable with respect to the cited art, in particular, the U.S. Patent Nos. 6,081,371; 6,005,710 and 4,786,154 by the limitations relating to the use of at least one optical switcher for the imaging module and display module which switcher optically connects the respectively module to the beam splitter in one or the other channel of the

Art Unit: 2872

instrument having a plurality of beam splitters and one binocular beam path constituting by two channels.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

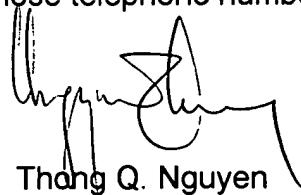
***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

\*\*\*